

REMARKS/ARGUMENTS

Claims 1-24 are pending in this application. Claims 25-39 have been cancelled. Claims 1 and 13 are independent claims. New Claims 40 and 41 have been added. Support for Claims 40 and 41 is found throughout the specification and drawings of Applicant's specification. No new matter has been added.

Claim Rejections – 35 U.S.C. § 103

The Patent Office rejected claims 1, 2, 13, and 14 under 35 U.S.C. § 103(a) as being unpatentable over Cockrill et al. ("Cockrill", U.S. Patent Number 6,473,740) in view of Freund et al. ("Freund", U.S. Patent Number 6,138,169). Claims 3-6, 8-12, 15-18, 20-24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Cockrill in view of Freund and further in view of Saulpaugh et al. ("Saulpaugh", U.S. Patent number 5,590,334). Claims 7 and 19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Cockrill in view of Freund and further in view of Sato. Applicant respectfully traverses these rejections.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Ryoka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974). *See also In re Wilson*, 165 U.S.P.Q. 494 (C.C.P.A. 1970).

Further, "to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." (emphasis added) (MPEP §

2143). If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. (emphasis added) *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Claims 1 and 13 stand rejected under 35 U.S.C. §103(a). Claims 1 and 13 each recite an element of “the content and transaction information are encapsulated in the transaction object.” (emphasis added)

As noted by the Examiner, Cockrill fails to teach, suggest, or disclose “transaction as object, the content and transaction information is encapsulated in the transaction object.” (Office Action, Page 3).

However, the Patent Office relied on Column 5, Lines 27-31 of Freund for teaching “transaction as object, the content and transaction information is encapsulated in the transaction object.” (Office Action, Page 3). The text from Freund cited by the Patent Office discloses:

A transactional object is an object whose behavior is affected by being invoked within the scope of a transaction. A transactional object typically contains or refers to persistent data that can be modified by transactional requests. (Column 5, Lines 27-31 of Freund)

The cited passage merely teaches a transaction object containing persistent data. In Freund, “persistent data is that data that will survive a system restart. Persistent data typically resides on disk storage devices, non-volatile memory or similar devices.” (Column 5, Lines 32-34 of Freund). Applicant respectfully submits that the Patent Office misinterpreted a *transaction* object in Freund. The transaction object in Freund is merely concerned about an “*object transactions service*” that provides *interoperation* among object oriented applications (OMG object oriented OTS applications) and procedural transaction applications (existing Encina procedural transaction managers). (Column 3, lines 46-49 of Freund). Nowhere in Freund is a “transaction object” which is utilized for containing transaction information such as billing information and security information disclosed, suggested or taught. Thus, Freund fails to teach, suggest, or disclose “the content and transaction information are encapsulated in the transaction object,” as recited in Claims 1 and 13

However, the Patent Office asserted that “It would be obvious to one having ordinary skill in the art ... because Freund’s transaction as object, the content and transaction information are encapsulated in the transaction object system would improve efficiency of Cockrill’s system by allowing the object oriented system to operate with existing of procedure transaction processing system.” (Office Action, Page 3)

The mere fact that the prior art may be modified in the manner suggested by the Patent Office does not make the modification obvious unless the prior art suggested the desirability of the modification. Further, “[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443 (Fed. Cir. 1992) *quoting In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988).

The Dean statement is of the type that gives only general guidance and is not at all specific as to the particular form of the claimed invention and how to achieve it. Such a suggestion may make an approach “obvious to try” but it does not make the invention obvious. We recognize that given the teaching in appellant’s specification regarding incorporation of the gene into the chromosome and utilizing the bacteria in the plant environment, one can theoretically explain the technological rationale for the claimed invention using selected teaching from the references. This approach, however, has been criticized by our reviewing court as hindsight reconstruction. *Ex parte Obukowicz* at 1065.

Applicant respectfully submits that none of the references discloses or suggests the desirability of the modification in the manner asserted by the Patent Office. The transaction object of the present invention contains transaction information useful for content/service providers to control distribution of the content or service while, in Cockrill, a procedure transaction processing system (*a transaction network*) facilitates and simplifies *purchase transactions* between customers and merchants and in Freund, a

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transaction object is utilized to provide *interoperation* between processing of an object oriented transactional request and a procedural transactional request. Thus, the references are relied upon for selected elements, but the desirability of the elements in the combination has not been supplied absent the present application. It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious.

Thus, Applicant respectfully submits that independent Claims 1 and 13 are nonobvious under 35 U.S.C. § 103. Removal of the pending rejections to Claims 1 and 13 under 35 U.S.C. §103 is respectfully requested. Claims 2-12 depend on Claim 1. Claims 14-24 depend on Claim 13. Claims 2-12, and 14-24 are believed to be allowable based on their dependence upon allowable base claims.

CONCLUSION

In light of the forgoing, reconsideration and allowance of the claims is earnestly solicited.

Respectfully submitted,

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